

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In the Patent Application of:

GIANPIERO SANTACATTERINA ET AL.

Serial No.: 10/757,891

Filed: January 15, 2004

For: A PROCESS FOR MANAGING AND CURTAILING POWER DEMAND OF APPLIANCES  
AND COMPONENTS THEREOF, AND SYSTEM USING SUCH PROCESS

Group Art Unit: 2121

Examiner: Norton, Jennifer L.

Confirmation No: 4773

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Sir:

**REPLY BRIEF**

The Examiner's Answer in the above-identified matter raises new issues which warrant this reply by Appellants. Appellants incorporate by reference all arguments made in its initial Appeal Brief. This Reply Brief will not reiterate any arguments of the Appeal Brief but will only respond to the new issues raised by the Examiner's Answer. The heading below refers to the heading in the Examiner's Answer.

### RESPONSE TO ARGUMENT

In paragraph 2, on page 21, the Answer improperly attempts to limit the scope of the claims. The Examiner asserts that Appellants may not rely on certain features because those features are not recited in the rejected claims. The Examiner states that, “[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. (*Examiner’s Answer*, at page 21, paragraph 2 (citing *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993))). The Examiner misconstrues the case law regarding interpretation of claims in light of the specification and seems to be ignoring the first part of the statement and focusing solely on the second part.

It is wholly improper to not construe the claims in light of the specification. The proper role of the specification in construing the claims was addressed by the Federal Circuit in *Teleflex, Inc. v. Ficos North America Corp.*, 299 F.3d 1313, 1324-1328 (Fed. Cir. 2002). It has long been held that “[t]he claims must be read in view of the specification, *see Markman*, 52 F.3d at 979, 34 U.S.P.Q.2D (BNA) at 1329, but [that] limitations from the specification are not to be read into the claims, *see Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186, 48 U.S.P.Q.2D (BNA) 1001, 1005 (Fed. Cir. 1998).” *Teleflex, Inc. v. Ficos N. Am. Corp.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002). This means that while claims are interpreted in light of the specification not everything expressed in the specification must be read into all the claims. *See Teleflex, Inc. v. Ficos N. Am. Corp.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002) (citing *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957, 220 U.S.P.Q. 592, 597 (Fed. Cir. 1983)). Just because all of the limitations from the specification are not read into all of the claims does not mean that the Examiner can ignore the specification when interpreting the claim language related to the “energy consumption profile.”

In this case the specification states that: The process comprises the steps of assessing for each appliance an energy consumption profile of the one or more appliances corresponding to its setting, *Application*, p. 8, [0030], ln. 1-8, Fig. 7, summing the energy consumption profiles to determine if their sum leads to one or more peaks in power demand, *Application*, p. 8, [0030],

ln. 8-9, Fig. 7, and providing one or more new energy consumption profiles to the one or more appliances for leveling the total power absorbed by the one or more appliances. *Application*, p. 8, [0030], ln. 8-9, Fig. 7; p. 10, [0037], ln. 2-3 – p. 11, [0037], ln. 1-3, Fig. 9. The control unit is adapted to assess, for each appliance, an energy consumption profile corresponding to its setting. *Application*, p. 8, [0029], ln. 1-4, p. 9, [0031], ln. 1-15, p. 10, [0033], ln. 1-3, p. 10, [0037], ln. 2-3 – p. 11, [0037], ln. 1. The control unit is adapted to sum the energy consumption profiles in order to check if their sum leads to one or more peaks in the power demand and to provide one or more new energy consumption profiles in order to level or reduce the total power absorbed by the one or more appliances or components thereof. *Application*, p. 8, [0030], ln. 8-9, Fig. 7, p. 8, [0030], ln. 8-9, Fig. 7; p. 10, [0037], ln. 2-3 – p. 11, [0037], ln. 1-3, Fig. 9.

The specification describes that an energy consumption profile is forward looking. *Application*, p. 1, [0004], ln. 1-3; *Application*, p. 3-4, [0016], ln. 11- *Application*, p. 4, [0016], ln. 3; *Application*, p. 9, [0031], ln. 4-5. When explaining the energy consumption profiles the specification discusses the “forecasts of power demand” and defines the energy consumption profile as consumed power over time for an appliance. *Application*, p. 11, [0038], ln. 4-5, Fig. 9. Based on the case law it is clear that the claims are to be interpreted in light of the specification and that the energy consumption profiles should be construed as forward looking.

In short, the forward looking or future aspect of the new consumption profiles is the crux of the appeal. Throughout the prosecution the Examiner has applied non-forwarding looking prior art to the claims, which Appellants truly believe are limited to providing the appliance(s) with forward looking or future consumption profiles because the term energy consumption profile is, by definition, forward/future looking.

In paragraph 3, on page 21, the Examiner improperly asserts that Appellants offer two different definitions for “energy consumption profile.” This is untrue because the two definitions are consistent and do not provided differing definitions. The first portion of the appeal brief states that “...an energy consumption profile, [] is the power absorbed by the appliance as a function of time during operation of the appliance...” *Appeal Brief*, page 10, paragraph 2. The

second portion of the appeal brief states that “‘energy consumption profile’” has a very specific meaning and refers to the *future power consumption* of the appliance over time.” *Appeal Brief*, page 11, paragraph 1. The second statement expands on the first and describes that the power absorbed by the appliance as a function of time is forward looking. The two statements are compatible and do not differ from each other.

In paragraph 1, on page 22, the Examiner again improperly attempts to limit the claim language by stating that the “future power consumption” referred to by Appellants only applies to claims 5 and 10. Claims 5 and 10 both include the following language “on the basis of the new leveled energy consumption profiles, a signal related to future energy consumption profiles is provided, such signal being adapted to be used by a control unit supervising more appliances and/or a utility company in order to have a forecast for future total energy consumption on the mains.” Claims 5 and 10 are respectively dependent on claims 1 and 6. The language of claims 5 and 10 expressly states that *a signal related to the future energy consumption profiles is provided*. (Emphasis added). The common understanding of the term “related” is something that is associated or connected with, or something that is linked or joined. (See <http://dictionary.reference.com/browse/related>). The language of claims 5 and 10, then, demonstrates the palpable link between claims 5 and 10 and claims 1 and 6, namely that the energy consumption profiles are forward looking in the independent claims 1 and 6 from which claims 5 and 10 respectively depend. No signal *related* to future profiles could be provided if the independent claims were not, in fact, already forward looking.

In paragraph 2, on page 30, and paragraph 1, on page 31, the Examiner improperly attempts to link the obviousness rejection of claims 1, 2, 4, 11 and 12 over the combination of Ehlers ‘438 and Nierlich ‘509 to the anticipation rejection of claims 1, 2, 4, 11 and 12 over Ehlers ‘438 (the Examiner previously improperly attempted to link the obviousness rejection of claims 5 and 10 over the combination of Ehlers ‘438 and Nierlich ‘509 to the anticipation rejection of claims 1, 2, 4, 11 and 12 over Ehlers ‘438). Never during the prosecution has the combination of Ehlers ‘438 and Nierlich ‘509 been applied to claims 1, 2, 4, 11, and 12. To the

extent that the Examiner is now attempting to do so, to the extent that the combination of Ehlers '438 and Nierlich '509 was improper for claims 5 and 10 it is also improper for claims 1, 2, 4, 11 and 12.

In paragraph 3, on page 31, the Examiner asserts that in Appellants' argument over the rejection of the combination of Ehlers '438 and Nierlich '509 the Appellants argues against the references individually. This is incorrect. Appellants' argument states that "there is no evidence that Ehlers '438 combined with Nierlich '509 is forward looking." See *Appeal Brief*, page 16, paragraph 4). Further, Appellants assert that "[t]he combination of Ehlers '438 and Nierlich '509 do not teach such a forward looking system because neither of the references discloses this concept." See *Appeal Brief*, page 17, paragraph 1. The Appellants support this argument by showing that neither Ehlers '438 nor Nierlich '509 individually teach the concept of a forward looking system. Examining the individual teaching of each reference to discern what the combination teaches is not arguing the references individually.

Ehlers '438 does not disclose or utilize an energy consumption profile in the system described therein. Nothing in Ehlers '438 even suggests the establishment of power consumption profiles for the power consuming devices, the summing of such profiles, or the generation of new energy consumption profiles for leveling the total power consumed by the power consuming devices. To the extent that Ehlers '438 is concerned with power consumption, it is limited to the historical power consumption and the current power consumption, which are not the claimed power consumption profile. As Ehlers '438 does not even disclose an energy consumption profile, Ehlers '438 cannot possibly teach a forward looking energy consumption profile. Further, the Examiner cites Figure 4, element 48 as disclosing the claim 1 element "assessing for each appliance an energy consumption profile." However, Figure 4 has nothing to do with an energy consumption profile. Figure 4 is a block diagram and flow chart for the software programs executed by the first microcomputer 18 and the second microcomputer 22. Significantly, there is no element 48 shown in Figure 4. Moreover, as discussed above, Ehlers '438 does not disclose or in any way refer to an energy consumption profile. Thus, the

Examiner's citation does not support the Examiner's position.

Nierlich '509 does not disclose summing of power consumption profiles for power consuming devices, or the generation of new energy consumption profiles for leveling the total power consumed by a plurality of power consuming devices. Nierlich '509 does not disclose the summing of power consumption profiles for the power consuming devices, or the generation of new energy consumption profiles for leveling the total power consumed by the power consuming devices, as called for in claims 1 and 6. Nor does Nierlich disclose forward looking energy consumption profiles. The claimed invention is forward looking because the claimed invention is based on the settings chosen for each appliance which correlate to predefined power consumption profiles (*See Application*, p. 8, ln. 14-21, Fig. 7). Whereas, Nierlich '509 can anticipate demand peaks and curtailment scheduling based on past power consumption records only and is not forward looking. The combination of Ehlers '438 and Nierlich '509 does not teach such a forward looking system because neither of the references discloses this concept. As neither teaches the element combination also would not teach the element.

Appellants assert that describing individual references, and identifying what they do and do not disclose, is not attacking references individually. Appellants' arguments are in all cases directed to the deficiencies in the combinations, after identifying the deficiencies in each individual reference making up the combination. This is entirely proper as the combination would necessarily be made from the elements of each reference forming the combination. Appellants' discussion of a particular reference in the combination is for ease of understanding so that the reader may better understand the combination. However, such a specific reference is not arguing the combination against a single reference, but is explaining what the combination would teach or disclose. Appellants are simply asserting that the combination is based on the teachings of the two references and that since neither has the element the combination would also not have the element.

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In view of the forgoing, reversal of the Examiner on all grounds is respectfully requested.

Respectfully submitted,

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Dated: September 15, 2008

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